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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,556	09/14/2001	Brett P. Monia	RTS-0250	7962

7590
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05/15/2003

EXAMINER

GIBBS, TERRA C

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,556

Applicant(s)

MONIA ET AL.

Examiner

Terra C. Gibbs

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 2, and 4-10 and 12-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

This Office Action is a response to the Amendment filed 4/4/03, in Paper No. 7.

Claims 3, 11 and 16-20 have been canceled. Claim 1 has been amended.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the compounds targeted to different target regions of SEQ ID NO: 3 in claim 1 are subject to restriction. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of nucleotide sequences to be claimed in a single application. Under this policy, up to 10 of independent and distinct nucleotide sequences will be examined in a single application. (see MPEP 803.04 and 2434).

Claim 1 claims a compound targeted to a 5'-untranslated region, a coding region, a stop codon region, or a 3'-untranslated region of a nucleic acid molecule of SEQ ID NO: 3, which are targeted to a nucleic acid encoding human fibroblast growth factor 2. Although the compounds claimed each targets the expression of the same gene, the compound targeting the recited target region sequences are considered to be unrelated, since each compound claimed is structurally and functionally independent and distinct for the following reasons: Each compound has a unique sequence (nucleotide, for example) corresponding to the recited target region, each compound targets a different and specific region of a nucleic acid encoding human fibroblast growth factor 2, and each compound,

upon binding to a nucleic acid encoding human fibroblast growth factor 2 functionally modulates (increases or decreases) the expression of the gene and to varying degree (per applicants' Table 1 in the specification). Furthermore, a search of more than one (1) of the target region sequences recited in claim 1 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed sequences. In view of the foregoing, one (1) target region is considered to be a reasonable number of sequences for examination.

Further, MPEP 808.02 states in part:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(c) - 806.05(i), the Examiner, in order to establish reasons for insisting upon restriction, must be shown by appropriate explanation of one of the following:

(c) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together.

It is noted that a search of the available sequence databases produces a listing of references disclosing the sequence most similar to the query sequence (target region). This is the "place" where the Examiner searches for prior art. The prior art relating to another query sequence (a different target region) will not be found in this "place"- a different listing of references must be generated and searched by the Examiner. Thus, a different search is shown, and restriction is proper.

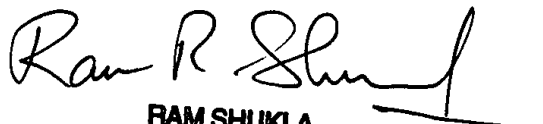
Accordingly, applicants are required to elect a single targeted region of a nucleic acid encoding human fibroblast growth factor 2 as recited in claim 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terra C. Gibbs whose telephone number is (703) 306-3221. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8693 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

tcg
May 15, 2003


RAM SHUKLA
PRIMARY EXAMINER